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for the
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DISTRICT OF COLUMBIA

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No. 7161

In the United States Court of Appeals for the District of Columbia

THE AMERICAN STEEL AND WIRE COMPANY OF NEW JERSEY, APPELLANT
v.
CONWAY P. COE, COMMISSIONER OF PATENTS, APPELLEE

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE COMMISSIONER OF PATENTS

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In the United States Court of Appeals for the District of Columbia

October Term, 1938

No. 7161

The American Steel and Wire Company of New Jersey, appellant

v.

Conway P. Coe, Commissioner of Patents, appellee

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE COMMISSIONER OF PATENTS

This is an appeal from the decree of the lower court (R. p. 11) dismissing the bill of complaint brought under the provision of Section 4915 R. S. (U. S. C., title 35, sec. 63.)

By that bill it was sought to have the Commissioner of Patents authorized to issue to plaintiff a patent upon the application of James Forrest Howe, Serial No. 504,623, which is assigned to the plaintiff, containing claims 10, 11, and 12, as set out in paragraph V of the bill (R. pp. 3, 4).

The Howe application is for a method of making suspension bridge cables. The Patent Office tribunals held the claims in question unpatentable over the following prior art:

Engineering Record, Nov. 2, 1912,
Greer, 411,499, Sept. 24, 1889,
Rieppel, 625,902, May 30, 1899.

During the taking of testimony there was introduced in evidence by the plaintiff the patent to Howe, No. 1,427,471, of August 29, 1922.

As stated above, the examiner and the Board of Appeals had relied upon other prior art. The District Court in its memorandum opinion (R. pp. 9–11) referred only to the Howe patent. In the brief for appellant it is said (p. 6) that the Howe patent was "not before the court" and, further, "it is submitted this patent was not properly before the court for consideration." It is further stated that the Howe patent "not being relied upon by the defendant, should not have been relied upon by the court."

It is difficult to see upon what theory it could be said that a patent introduced in evidence by the plaintiff was not before the court.

A suit under Section 4915 R. S. is not, as has been repeatedly stated by the courts, the same as an appeal from a refusal of the Patent Office to issue a patent, but is a proceeding *de novo* and additional evidence may be submitted both by the plaintiff and the defendant. It would seem obvious, therefore, that not only was the Howe patent before the court for consideration but it was the duty of the court, if in its opinion that patent was a sufficient ground for holding there was no invention in the claims in suit, to so state and refuse to authorize the issuance of a patent on the claims in suit.

The Howe application appears on pages 38 *et seq.* of the record and purports to be for cables and the method of making the same. This application set out what had been the prior methods and stated that the object of the invention was the provision of a cable of the class used in making suspension bridges of novel construction wherein the necessary strength, compactness and durability are obtained and the cable constructed in a rapid, effective and economical manner. It was also pointed out that it had been the custom in preparing the cables for a suspension bridge to stretch the individual wires of the cable between the anchorages or cable supports, the wires being passed back and forth singly between the anchorages for the cable ends until the required number is in position, and that this was a tedious method since each individual wire must be stretched and its ends securely anchored. It was then stated that in the process here involved the wires of which the cable is to be composed are formed by twisting them into a series of strands, each strand being laid up at the mill by means of an automatic stranding machine and that the completed strands were shipped to the bridge site where the cable was to be used, and there assembled in lengthwise parallel relation. It was also stated that the strands, after being formed in the stranding machine, are measured, stretched, and otherwise conditioned and are equipped with end fastenings of any approved form at the mill.

The Office tribunals were of the opinion that the claims define no invention over the prior art cited by the examiner. In its decision the Board of Appeals stated (R. p. 87) that the Greer and Rieppel patents broadly disclosed such a procedure in that the strands were formed of individual wires at the mill and according to Rieppel's method even the predetermined right length for the prospective bridge was prepared.

The Board further stated that while the specific features of stretching and conditioning the wires of the cable were not definitely disclosed in the prior art, it was believed that this was an obvious feature well within the skill of those working within the art.

The Howe patent (R. p. 95 et seq.) discloses a similar process of forming suspension bridge cables. The language of the specification of the Howe application as to what was the prior procedure and the difficulties of forming the bridge cables from single wires is almost word for word the same as the similar description in the first column of the first page of the Howe patent.

In the Howe patent, however, the individual elements of the cable were what are referred to in the record as ropes, described as having been made of units consisting of a center strand and a plurality of other strands laid spirally therearound and that these strands were arranged in the cable spirally around a core strand.

In the Howe application in suit the cable is formed of a series of strands which are arranged longitudinally in the cable. In the specification it is stated that the individual strands are successively pulled or stretched across the space the cable is to span and each strand is secured at its ends to the anchorages and that when all the strands have been fastened in place they are formed into a compact series of lengthwise parallel strands, the assembled strands being then rigidly bound together by wrapping the seizing around them at short intervals in the length of the cable.

The District Court in its decision stated that practically the only difference between a cable manufactured under the applicant's 1922 patent and the one manufactured by the process in suit is that the latter would be stretched and measured at the mill. The court then pointed out that applicant claimed no new method of stretching and did not describe how it was done nor did he describe in detail the vague term "conditioning" and it is thought that the additional steps involved merely mechanical skill.

10. The claims in question read as follows:

> 10. The method of making suspension bridge cables which consists in forming a series of wires into spirally wound strands of the required length and diameter and stretching, conditioning, measuring, and attaching end fastenings to the so formed strands in the mill, then assembling a series

of the so formed strands in lengthwise parallel relation at the bridge site, and fastening the assembled strands together in completing the cable.

11. The method of making suspension bridge cables which consists in forming a series of wires into spirally wound strands of the required length and diameter and stretching, conditioning, measuring, and attaching end fastenings to the so formed strands in the mill, then assembling a series of the so formed strands in lengthwise parallel relation at the bridge site, and fastening the assembled strands together and fastening their ends to anchorages in completing the cable.

12. The method of making suspension bridge cables which consists in forming a series of wires into spirally wound strands of the required length and diameter, then measuring stretching, and securing end fastenings to the so formed strands at the mill, then assembling a series of the so formed strands in lengthwise parallel relation at the bridge site, and then anchoring the ends and binding the assembled strands together in completing the cable.

Appellant's argument as to invention is predicated primarily on the "stretching, conditioning, measuring, and attaching end fastenings to the so formed strands in the mill." It is urged that neither the Howe patent nor the other prior art suggests this mode of operation. But, as pointed out in the court's memorandum opinion the Howe patent gave as much information as to the method of manufacturing as does the application in suit, with the exception, of course, of the stretching, conditioning, and measuring.

It would seem that in view of the art and the knowledge, as shown by the record, of the making of cables for bridges, there was no invention in the additional details of stretching, conditioning, and measuring at the mill over what was shown in the Howe patent.

There was nothing new in making a cable by laying strands in parallel relation, as the art clearly shows. Howe having taught how a cable could be made by treating the individual elements at the mill rather than by stretching the individual wires from one anchorage to the other, there was no further invention in the generally stated steps of stretching, conditioning, and measuring.

It is urged that the method of the applicant has gone into extensive use but it is well settled that commercial use of an apparatus or process is a factor to be taken into consideration in determining whether invention was involved only if there is any doubt as to invention. (See *Altoona Publix Theatres, Inc.,* v. *American Tri-Ergon Corporation et al.,* 294 U. S. 477, 1935 C. D. 785.) As one of the courts has well said, commercial use cannot create a doubt and then resolve it in favor of the applicant or patentee.

Nor does the mere fact that the present process may be an improvement over the process of the

Howe patent of 1922 of itself establish invention. As was said by the Supreme Court of the United States in the old case of *Pearce* v. *Mulford et al.*, 102 U. S. 112–117, 1880 C. D. 667, the device shown may be an improvement over what had gone before and yet be not patentable because the making of the improvement did not require the exercise of the inventive faculties.

Some stress is laid in the brief upon the lower court's statement that the present application to secure a patent would seem to be an attempt to extend applicant's monopoly for another seventeen years and it is argued that a patent containing the claims in suit would in no way preclude the use by the public of the process of the Howe patent.

It is not necessary to consider whether the statement of the court below in that respect is entirely accurate because whether the claims here involved if patented would prevent the use of the older process or not the patent should not be allowed unless it is clearly established that these claims in and of themselves define an invention over what was known in the prior art.

It is submitted that the claims are properly refused because of the lack of the exercise of invention over what was old and that the decision of the lower court should be affirmed.

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